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EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1771

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/749,805
Filing Date: December 31, 2003
Appellant(s): POLANCO ET AL.

Maxwell Petersen
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 17 2006
GROUP 1700

This is in response to the appeal brief filed 8/28/2006 appealing from the Office action mailed 8/5/2005. It is noted that the appeal brief lists J. Pierce as the examiner. Although J. Pierce wrote the final rejection, A. Piziali has prepared this Examiner's Answer.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is partially correct: The appellant incorrectly states (see page 4) that the specification gives a person having ordinary skill in the art the necessary information for understanding and practicing the claimed inventions.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partially correct. The changes are as follows: The examiner has withdrawn ground of rejection B (35 USC 112 second paragraph rejection) based on the arguments presented. The examiner has withdrawn ground of rejection E (provisional double patenting rejection) based on the filing of the terminal disclaimer on 4/17/2006.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,382,400	PIKE	1-1995
5,770,531	SUDDUTH	6-1998

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-9, 20-22, 24-38, 40-46, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims recite various formation index values for either the top side or the wire side of the web, based on the bulk value or the basis weight of the web. However, the specification does not teach a person of ordinary skill in the art how formation index correlates with the bulk of the web, nor does the specification teach how the formation index correlates with the basis weight of the web. For example, claim 9 recites the web has a formation index averaging above

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31.6 on the wires side when the basis weight is about 6.0 osy. Then it recites the formation index raises to above 37.09 when the web weighs 2.5 osy. But then the claim states that the formation index falls to above 35.03 when the web weighs 2.25 osy. There is no discernable trend between these values, and the specification does not teach a person of ordinary skill in the art why a web, when it has a certain weight (or bulk), would then have the claimed formation index values on the wire side or top side. Why are these differing results achieved? How is the web made in order to arrive at these values? Similar analysis applies for the other rejected claims.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pike et al. (U.S. Patent No. 5,382,400).

Pike et al. teach a nonwoven web made of continuous bicomponent filaments that are Crimped (Abstract). Although Pike et al. does not explicitly teach the limitations concerning formation index, it is reasonable to presume that said limitations are inherent to the invention.

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Support for said presumption is found in the use of similar materials (i.e. spunbonded bicomponent filaments) and in the similar production steps (i.e. crimping in a manner that forms a more uniform surface) used to produce the nonwoven fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed formation indices would obviously have been provided by the process disclosed by Pike et al. because Pike et al. teach the crimping step forms a stable and uniform fabric with high loft (column 3, lines 20-26). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. The basis weight of the fabric may range from 0.25 to 5 osy (column 9, line 57).

With regard to claims 10-15 and 27-30, the Examples in Tables 1-9 show deniers within Applicant's claimed ranges. With regard to claims 19 and 34, Pike et al. teach the fabric is through-air bonded (column 9, line 47).

Claim Rejections - 35 USC § 103

6. Claims 16-18 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pike et al. (U.S. Patent No. 5,382,400) in view of Sudduth et al. (U.S. Patent No. 5,770,531).

Pike et al. do not disclose adding titanium dioxide to the fibers. Sudduth et al. teach that titanium dioxide is often added to fibers in an amount of 2% by weight in absorbent products in order to provide a white coloring (column 4, lines 2-4). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add 2% titanium dioxide to the fibers of Pike et al. in order to provide white coloration to the absorbent product, as taught by Sudduth et al.

(10) Response to Argument

Ground of Rejection A: Claims 2-9, 20-22, 24-38, 40-46, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

The purpose of the requirement that the specification describe the invention in such terms that one skilled in the art can make and use the claimed invention is to ensure that the invention is communicated to the interested public in a meaningful way (see MPEP 2164).

The appellant asserts that there is no legal basis for a requirement of correlation or discernable trend under the statute. The examiner contends that because there is no discernable trend in the data disclosed by the current specification, one skilled in the art is not enabled to make (reproduce) and/or use the invention. For example, in code 1 (Example 1) in Table 3, each web “rep” (repetitions under the fiber deposition apparatus) is made with the same fibers and by the same process, yet the top side formation index varies from 23.7 to 49.9 while the bottom side formation index varies from 17.9 to 46.9. In some reps the top side formation index is greater than the bottom side formation index while in other reps the top side formation index is less than the bottom side formation index. The “formation index” property claimed by the appellant varies so greatly that any attempt to reproduce the claimed invention would result in tests results that would also vary greatly from those experienced by the inventors. Based on the claimed property failing to follow any discernable trend, one skilled in the art would not be enabled to make (reproduce) and/or use the invention.

Ground of Rejection C: Claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pike et al. (U.S. Patent No. 5,382,400).

The appellant asserts that the nonwoven material disclosed by Pike does not inherently possess the claimed formation index property (less than 11% percentage difference between top side and wire side) because the present invention produces a nonwoven material by cold FDU production while Pike produces a nonwoven material by hot FDU production. The examiner respectfully disagrees.

Although the examiner agrees that Pike produces nonwoven material by hot FDU production, appellant's specification specifically acknowledges that the nonwoven material of Pike inherently possesses the claimed formation index property.

On page 21, lines 12-23, the current specification states:

“Selected for direct comparison with nonwovens according to the present invention is a nonwoven material of bicomponent spunbond fibers made according to Strack et al. (supra) available from Kimberly-Clark Corporation. Various descriptions of a bicomponent spunbond according to Strack et al. (supra) are taught in U.S. Pat. No. 5,336,552 to Strack et al.; U.S. Pat. Nos. 5,382,400 or 5,418,045 to Pike et al., and U.S. Pat. No. 6,436,328 to DiPalma each of which is herein incorporated in its entirety by reference. A bicomponent spunbond according to Strack et al. (supra) is used as a basis to compare the articles and methods of the present invention

since a bicomponent spunbond according to Strack et al. (supra) may generally comprise the same or similar components as the fibers of the present invention while being made by different techniques. For example, a bicomponent spunbond according to Strack et al. (supra) utilizes a hot FDU (e.g., 350.degree. F.) to draw the fibers such that the fibers arrive at the collection wire already crimped.” (underline emphasis added)

On page 28, lines 6-8, the current specification states:

“Example 14 was produced according to the above-described hot FDU bicomponent spunbond technology of Strack et al. (supra) to a basis weight of 199 gsm (5.87 osy), with a bulk of 8.9 mm (0.35 inches) and density of 0.022 g/cc.”

These cited portions of the specification clearly disclose that Example 14 was produced according to the teachings of Pike (cold FDU production) and the specification further discloses that Examples 15-20 were also produced according to the teachings of Pike (see descriptions of Examples 15-20 on pages 28-30 of the current specification). Table 3 illustrates the formation index of the top and bottom sides of the web materials (Examples 14-20) produced by Pike. As acknowledged by appellant's specification, after a vast number of web reps (repetitions under the fiber deposition apparatus) the top and bottom sides have a formation index percentage difference of less than 11% (see for example after rep 1 of code 14 in Table 3 wherein the formation index percentage difference between the top side and the bottom side is less than 4%).

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Therefore, at least one nonwoven material taught by Pike inherently possesses the claimed formation index limitation (even though after more reps the resulting nonwoven material may no longer possess the claimed formation index limitation). It is noted that Pike specifically discloses that polyethylene (PE) and polypropylene (PP) may be used in side-by-side configuration (column 6, lines 28-41), while specifically mentioning 6811A PE manufactured by Dow and 3455 PP manufactured by Exxon (see examples). These are substantially identical materials used in the Examples 14-20 of the current specification. Pike even mentions densities and basis weights (column 9, lines 47-63) substantially identical to those used in Examples 14-20 of the current specification.

It is noted that claims 2-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 are not separately argued. Therefore, if the board finds the examiner's claim 1 arguments persuasive, the board is requested to select claim 1 from the group to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim.

In the event that the board selects a claim drawn to a formation index average property (see for example independent claim 35), the examiner contends that the nonwoven web taught by Pike inherently possesses the claimed formation index average property. Firstly, although Table 3 only illustrates the average formation index over 20 reps, the current claims do not require that the formation index average be formulated over 20 reps. Therefore, the current specification acknowledges that Pike teaches a nonwoven web with the claimed formation index average. For example, see code 20 wherein Table 3 lists the formation index average as 37.6 when the bulk is 0.071 inches. Although the formation index of 20 reps is not greater than 37.6, the nonwoven web has a formation index average of 37.8 (greater than 37.6) after 18 reps. Secondly, the

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appellant claims "above about 37.6". The examiner contends that the claim language allows for a formation index value of slightly less than 37.6, or even exactly 37.6. The examiner contends that 37.6 is "above about 37.6."

Ground of Rejection D: Claims 16-18 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pike et al. (U.S. Patent No. 5,382,400) in view of Sudduth et al. (U.S. Patent No. 5,770,531).

The appellant fails to further argue the patentability of claims 16-18 and 31-33, rather, the appellant asserts that the claims are allowable for the same reasons that claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49 are allegedly allowable. In response, the examiner repeats the arguments set forth above regarding claims 1-15, 19-22, 24-30, 34-38, 40-46, 48, and 49.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

atp

9/22/06

**ANDREW T. PIZIALI
PATENT EXAMINER**

Conferees:

Terrel Morris

Jennifer Kolb-Michener